

#### **IV. REMARKS**

Applicants have considered the Office Action with mailing date of June 20, 2006. By this amendment, claims 6, 15 and 24 have been amended. As a result, claims 1-26 remain pending in this application. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 9 and 18 are rejected under 35 U.S.C. §112, ¶ 2 as allegedly being indefinite. Claims 1-5, 7-14, 16-23 and 25-26 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,002,871, hereafter “Duggan.” Claims 6, 15 and 24 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Duggan in view of “The JAVA <sup>TM</sup> Virtual Machine Specification” by Lindholm, hereinafter “Lindholm”. Applicants respectfully traverse the rejections on the following grounds.

##### **A. REMARK ON SPECIFICATION**

In the Office Action, the Office notes the use of the trademark “JAVA” in the specification. Applicants respectfully submit that appropriate amendments have been made in the specification and claims to prevent the use of the term in any manner that would diminish its validity as a trademark. As a result, Applicants respectfully request withdrawal of the objection to the specification.

## **B. REJECTION OF CLAIMS 9 and 18 UNDER 35 U.S.C. §112, ¶ 2**

The Office asserts that claims 9 and 18 are indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office states that claims 9 and 18 do not indicate the steps for the alternative to “...providing a test application that satisfies reentrancy requirements on a client...”. Applicants regard the method steps, *inter alia*, set out in claim 9 and 18 as the claimed invention and actions performed with respect to test applications that do not meet the reentrancy requirements are not subject matter that is claimed and hence are not addressed. Therefore, an alternative is not required in the claims 9 and 18. With respect to the Office’s remark on the use of the phrase “reentrancy requirements” in the claimed invention, Applicants respectfully assert that this is a term in the art that would be readily understood by one of ordinary skill in the art. Accordingly, Applicants request that the rejection be withdrawn.

## **C. REJECTION OF CLAIMS 1-5, 7-14, 16-23 and 25-26 UNDER 35 U.S.C. §102(b)**

With regard to the 35 U.S.C. §102(b) rejection over Duggan, Applicants assert that Duggan does not teach each and every feature of the claimed invention. For example, with respect to independent claims 1, 9 and 18, Applicants assert that Duggan fails to teach, *inter alia*, “... each of the plurality of instances of the test application run within a single process”. In support of the rejection, the Office cites col. 21, lines 53 – 57 in Duggan which provides “...[a] basic module 12 is also responsible for initiating multiple, concurrent sessions”. In Duggan, the basic module 12 is but one of a “... plurality of separate Visual Basic code modules ...” of a core module of the test tool

program (col. 21, lines 41 – 45) responsible for “... initiating concurrent sessions on different client connections...” However, Duggan fails to disclose that concurrent sessions run in a single process. Instead, the remaining Visual Basic modules come in to play in carrying out the various aspects of the test tool. To this extent, Duggan’s basic module’s responsibility is not equivalent to the claimed method step of “instantiating a plurality of instances ...using threads, wherein each of the ... instances run within a single process”. Claim 1. Claims 9 and 18 include similar features. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

With further respect to dependent claim 2, Applicants respectfully assert, in addition to the above arguments, that Duggan also fails to teach, *inter alia*, “... identifying application protocol interfaces (APIs) ..., prior to the instantiating step...”. Claim 2. The Office cites col. 12, lines 21 – 23 in Duggan, which provides “A list box 272 ...all the commands in command module for ...testing a given application program” in support of its rejection. As defined in col. 5, lines 57 – 62, “A ‘command’ is a series of program instructions which ...cause ...the test tool program to perform a use function of the web application under test via a client connection” but does not disclose or explicitly teach the treatment of application protocol interfaces (APIs). In contrast to Duggan, the claimed invention discloses a method step for “identifying APIs ...prior to instantiating step”. To this extent, Duggan teaches a command module with commands for creating a test script but does not teach identifying APIs.

Additionally, Applicants further assert that Duggan also does not teach, *inter alia*, “providing a test script capable of invoking the APIs ...” In support of the rejection, the Office states that “[the] test operator” in col. 13, lines 59 – 62 in Duggan is equivalent to

the claimed "... a test script ...". However, Duggan's test operator teaches the "[creation of] test scripts containing command module commands" but does not teach the invocation of APIs. As such, the claimed test script that is capable of invoking the APIs is not equivalent to Duggan's test operator that is capable of creating test scripts with command module. Accordingly, Applicants request that the Office withdraw the rejection of claim 2.

With respect to dependent claims, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicants submit that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicants respectfully request withdrawal of this rejection.

#### **D. REJECTION OF CLAIMS 6, 15 and 24 UNDER 35 U.S.C. §103(a)**

With regard to the 35 U.S.C. §103(a) rejection over Duggan in view of Lindholm, Applicants incorporate the foregoing discussion with respect to claims 1, 9 and 18 and assert that the combined teachings of Duggan and Lindholm do not teach or suggest each and every feature of the claimed invention. As noted by the Office on page 6 of the current Office Action, Duggan "does not disclose the process comprises a JAVA virtual machine". The Office cites Lindholm to remedy this deficiency in Duggan. Specifically, the Office states that it would have been obvious to a person of ordinary skill in the art to implement Duggan's 'test-tool' and 'basic module' in JAVA™ language/programs and execute them on a JVM. However, the Office has not established a rationale or suggested any guidelines that a person of ordinary skill in the

art would follow in implementing the teachings of Duggan in Lindholm's JVM. Duggan's 'test-tool' is implemented through multiple Visual Basic code modules collectively comprised within a core module, where the 'basic module' as one of a plurality of Visual Basic code modules. Col. 21, lines 30 – 46. In contrast to the claimed invention, Duggan's 'test-tool' does not teach "...instantiating a plurality of instances..., wherein each of the plurality of instances of the test application run within a single process". To this extent, Applicants assert that the Office has relied upon hindsight to derive a motivation for a person of ordinary skill in the art to combine the teachings of Duggan and Lindholm. Applicants respectfully submit that the suggestion/motivation to combine the teachings of two references has to originate from the teachings themselves or the knowledge in the art at the time of the invention and not hindsight, which is impermissible. Accordingly, Applicants respectfully request that the Office withdraw its rejection.


## **V. CONCLUSION**

In addition to the above arguments, Applicants submit that each of the pending claims is patentable for one or more additional unique feature. To this extent, Applicants do not acquiesces to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have

not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. W. LaBatt', with a stylized flourish at the end.

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